REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 24, 2006 (Paper No. 20061117). Upon entry of this response, claims 1-4, 6, 8, 11-46, and 48-52 are pending in the application. In this response, claims 1, 19-23, and 38-41 have been amended, claims 48-52 have been added, and claims 5, 7, 9-10, and 47 have been cancelled. Applicant respectfully requests that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. Rejection of Claims 1-3, 9, 11-19, 21, 23-37, 39, and 41-46 under 35 U.S.C. §102

Claims 1-3, 9, 11-19, 21, 23-37, 39, and 41-46 have been rejected under §102(e) as allegedly anticipated by *Vallone et al.* (U.S. 6,847,778). Applicant respectfully traverses this rejection. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

a. Claims 1 and 29

Applicant respectfully submits that *Vallone et al.* fails to teach, disclose or suggest at least "responsive to receiving the request for a trick mode operation, decoding a plurality of undecoded dependent frames in the video stream to create a decoded frame" as recited in claim 1, or "decoding logic configured to decode a plurality of undecoded dependent frames corresponding to the video stream to produce a single decoded frame, responsive to the determination logic determining that the request for the trick mode operation has been received" as recited in claim 29. The Office Action alleges that this feature is taught by *Vallone et al.* at Col. 7, lines 29-42. Applicant respectfully disagrees.

Vallone et al. describes a media switch 701 which is located between an encoder and a decoder. The media switch 701 receives an encoded video or audio stream, and which

identifies the start of a segment within the stream and stores this segment information as a tag. The tag is stored in a FIFO within the switch 701. The frame type of the segment (e.g., I-frame, B-Frame, P-frame, PES, sequence header), and the starting address of the segment, is stored in an event queue within the switch 701. The switch 701 outputs streams to video decoder 715 and audio decoder 717. Although *Vallone et al.* describes that the decoded stream may include dependent frames, and that decoders 715 and 717 decode these frames, *Vallone et al.* does not describe that a "plurality of undecoded dependent frames" is decoded to create or produce "a ***single*** decoded frame" as recited in amended claims 1 and 29.

Furthermore, *Vallone et al.* does not describe that the decoding of dependent frames "to create a ***single*** decoded frame" is done responsive to "receiving the request for a trick mode operation" as recited in amended claim 1 or responsive to "the determination logic determining that the request for the trick mode operation has been received" as recited in claim 29. *Vallone et al.* does discuss trick mode operation, but only as a reason for identifying the start of segments within in the stream:

> The parser 705 detects the beginning of all of the important events in a video or audio stream, the start of all of the frames, the start of sequence headers--all of the pieces of information that the program logic needs to know about in order to both properly play back and perform special effects on the stream, e.g. fast forward, reverse, play, pause, fast/slow play, indexing, and fast/slow reverse play."
> (Col. 7, lines 10-16.)

Thus, *Vallone et al.* does not describe "receiving the request for a trick mode operation" or "determin[ing] whether a request for trick mode operation has been received." Even assuming, *arguendo*, that receiving such a request is implied by this brief mention of trick mode, *Vallone et al.* does not suggest a connection between trick mode operation and "decoding a plurality of undecoded dependent frames" as recited in claims 1 and 29.

For at least the reason that *Vallone et al.* fails to disclose, teach, or suggest the above-described features, Applicant respectfully submits that *Vallone et al.* does not anticipate claims 1 and 29. Therefore, Applicant requests that the rejection of claims 1 and 29 be withdrawn.

b. Claims 2-3, 9, 11-19, 21, 23-28, 30-37, 39, and 41-46

Since claims 1 and 29 are allowable, Applicant respectfully submits that claims 2-3, 9, 11-19, 21, 23-28, 30-37, 39, and 41-46 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2-3, 9, 11-19, 21, 23-28, 30-37, 39, and 41-46 be withdrawn.

2. Rejection of Claims 2, 4-8, 10, 22, 38, 40, and 47 under 35 U.S.C. §103

Claims 2, 4-8, 10, 22, 38, 40, and 47 have been rejected under §103(a) as allegedly obvious over *Vallone et al.* (6,847,778) in view of *Aoki et al.* (6,009,231). To the extent that cancellation of the claims does not render the rejections moot, Applicant respectfully traverses this rejection. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 5, 7, and 47

Claim 5, 7, and 47 are cancelled without prejudice, waiver, or disclaimer, and the rejection of these claims is therefore rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicant so chooses, and does not intend

to dedicate any of the cancelled subject matter to the public. Applicant expressly reserves the right to present cancelled claim 5, 7, and 47, or variants thereof, in continuing applications to be filed subsequent to the present application.

b. Claims 2, 4, 6, 8, 10, 22, 38, and 40

The addition of *Aoki et al.* does not cure the deficiencies of *Vallone et al.* discussed above in connection with independent claims 1 and 29. Therefore, claims 2, 4-8, 10, 22, 38, 40, and 47 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 29 are allowable, Applicant respectfully submits that claims 2, 4, 6, 8, 10, 22, 38, and 40 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2, 4, 6, 8, 10, 22, 38, and 40 be withdrawn.

3. Allegations That Certain Features Are Well-Known

The Office Action has made the following allegations that certain features are well-known (location in the Office Action and claim relevance noted in parentheses):

> (Page 8, pertaining to claim 10) However, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to augment the range of Vallone et al. to combine a well known and old art of a non-volatile memory in order not to retain the stored information even when not powered. (Page 9, pertaining to claim 20) However, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to augment the range of Vallone et al. to combine a well know and old art of "the decoded frame is output determined based on an output picture rate" in order achieved a stable picture quality at a fixed rate.

Applicants respectfully submit that simply stating that the elements of the claim are well-known in the art is a conclusion that has not been supported in the Office Action by specific factual findings predicated on sound technical and scientific reasoning to support the conclusion, evidencing that indeed the subject matter of claims 10 and 20 are not well-known in

the art. The MPEP defines the standard with regard to taking official notice and "well-known" assertions. As provided in MPEP § 2144.03:

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))...
>
> If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Furthermore, Applicant respectfully submits that in the context of the claim language, such a finding of well-known use is also improper for at least the reason that such features are incorporated with independent claim features that provide a complexity not anticipated or suggested by the cited art of record. Accordingly, Applicant traverses the assertions of well-known use. Because of this traversal, the Office must support its findings with evidence, or withdraw the well-known determination.

4. Newly Added Claims

Applicant submits that new claims 48-52 are allowable over the cited references. Specifically, independent claim 48 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of "responsive to receiving the request for a trick mode operation, decoding a plurality of undecoded dependent frames corresponding to the video stream to create a single decoded frame if the video stream does not contain independent frame." Claims 49-52 are allowable over the cited references for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed.

Cir. 1988). Therefore, Applicant requests the Examiner to enter and allow the above new claims.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-4, 6, 8, 11-46, and 48-52 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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